

REMARKS/ARGUMENTS

This Amendment responds to the office action dated February 7, 2006.

The Examiner has rejected all pending claims under 35 U.S.C. § 103(a) as being obvious in view of combinations involving Pornrodeo, after concluding that applicant's affidavit under 35 U.S.C. § 131 was insufficient to antedate the reference. The Examiner makes three related arguments as to why the affidavit was insufficient. First, the Examiner posits that, although the applicant produced documentation of code that anticipated the disclosure of Pornrodeo, and declared that the code was archived on a computer with an archival date prior to the effective date of the reference, there was nonetheless no independent documentation of the date. Second, the Examiner asserts that the documentation fails to support the invention of the entire claimed subject matter. Third, the Examiner asserts that the documentation merely shows the "capabilities of the Javascript language." Each of these contentions is erroneous.

First, to antedate a reference, both case authority and the MPEP merely require an antedating declaration to aver facts that show inventorship prior to the effective date of the reference, and that the alleged facts be supported by *some* documentation. *See, e.g., In re Harry*, 333, F.2d 920, 142 USPQ2d 1385, 1388 (D.D.C. 1997); *see also* MPEP at 715.07. For example, the cited portion of the MPEP states that the "essential thing to be shown . . . is priority of the invention and this may be done by *any* satisfactory evidence of the facts. FACTS, not conclusions must be alleged. Evidence in the form of exhibits *may* accompany the affidavit or declaration" (italics added). Thus, nothing in the MPEP makes a specific requirement of documentary support of an invention *date* that is sworn to in the declaration, as contended by the examiner. To the contrary, the purpose of the requirement of documentation is to show *what* was achieved rather than *when* it was achieved. *See, e.g. Ex Parte Sanders*, 1883 C.D. 23 (1883) ("stating that the requirement of documentation is justified because the issue of whether prototypes, descriptions, and drawings embody the claimed invention is subjective and the patent office is entitled to review that decision independently, irrespective of whether the inventor actually believes himself that the prior activities embodied the claimed invention). Thus, while documentation is required to independently evaluate the subjective issue of *what* was

invented, the issue of *when* the documents were created or dated is *not* subjective, and a sworn assertion of the date a document was created is to be accepted by the patent office. See MPEP § 715.07 (applicant may *allege* that the date of documented reduction to practice was prior to reference)(emphasis added); *Herman v. William Brooks Shoe Co.*, 39 U.S.P.Q.2d 1773,1777 (S.D.N.Y. 1996)(patent office must accept allegations in statement at face value without investigation). Thus, the Examiner's assertion that the declaration was ineffective to overcome Pornrodeo for lack of supporting documentation of the date of reduction to practice is improper.

Second, the Examiner's assertion that the declaration is defective for failing to disclose the entire invention is improper. Pornrodeo teaches code that opens a background window in a browser and loads a web page into that window. The applicant notes that it is the Examiner's contention, and in fact the basis of the rejection of all the claims, that one of ordinary skill in the art would recognize in view of the combination of Pornrodeo and Landsman, which has a priority date prior to Pornrodeo, that an ad-server could be used to load an advertisement into the background window of Pornrodeo. This in spite of the fact that Landsman specifically teaches loading advertisements in a *foreground* window during an interstitial period of time when a user is moving to a new web site that has not yet loaded. Thus, there are two possibilities. The first is that the Examiner is incorrect, and one of ordinary skill in the art would not think to combine Landsman and Pornrodeo, in which case the rejection of the claims is improper and should be withdrawn. Alternatively, even if for sake of discussion the Examiner is correct, the applicant, by showing precisely what Pornrodeo teaches at a date prior to that reference, overcomes the combination of both references because applicant is credited with the knowledge of one of ordinary skill in the art at the time of the cited reference being antedated. See *In re Spiller*, 500 F.2d 1170, 182 U.S.P.Q2d 614 (CCPA 1974); *Hazeltine v. United States*, 230 USPQ2 721, 724 (Cl. Ct. 1986).

In fact, two court cases specifically reject the Examiner's position. The CCPA stated that, where an applicant shows a reduction of a first portion of a claimed invention prior to a cited reference that discloses that portion, and the entire rejection is rejected on grounds of obviousness in light of the cited reference, then the prior reduction to practice

is sufficient to overcome the obviousness rejection, even though it did not accomplish the entire claimed invention. "To hold [otherwise] would lead to an anomalous result, i.e. if appellant broadened his claims . . . so as to read literally on [the cited reference, it] would not be available as a reference against such claims because appellant's antedating affidavit would be satisfied in every respect. It cannot be the law that the same affidavit is insufficient to remove the same reference applied against the slightly narrower claims presented here." *In re Stryker*, 435 F.2d 1340, 168 USPQ 372 (CCPA 1974). This very logic was later extended to the circumstance where the obviousness rejection was based on a combination of references. *See In re Dardick*, 496 F.2d at 1234, 181 USPQ 834 (CCPA 1974).

Thus, while applicant certainly does not admit that the claimed invention is obvious in view of the combination of the cited references, the point is moot because even if it were obvious, by antedating Pornrodeo, the cited combination is overcome. The applicant further notes that new claim 41 presents the Examiner with the very dilemma that justified the *Stryker* and *Darden* decisions, i.e. broader claim 41 reads literally on Pornrodeo, and thus applicant's declaration overcomes it "in every respect", as the *Stryker* court put it. Thus rejecting the *narrower* claims 21-40 is improper.

Finally, the Examiner's assertion that the code provided with the declaration merely shows the capabilities of the JAVA code is both factually incorrect and irrelevant. The provided documentation shows a specific *implementation* of a method *using* the JAVA code, i.e. it shows a computer implemented method of loading an advertisement into a background window of a browser using the JAVA scripting language. The JAVA language, while capable of opening the new browser and forcing it into the background, does not instruct the public *what* to put into the new browser and *whether* to force it into the background. Thus the assertion that the provided documentation does nothing more than demonstrate the capabilities of the JAVA language is misplaced.

Moreover, it is irrelevant. By the Examiner's reasoning, no claim to a computer-executable program utilizing existing programming languages would be novel and non-obvious, because, by definition, the program is implemented using preexisting capabilities of programming languages.

Thus, either the Examiner's obviousness rejection is improper either because one of ordinary skill in the art would not combine Pornrodeo with Landsman to arrive at the claimed inventions, or it is improper because applicant's antedating declaration overcomes the rejection. Therefore, the Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

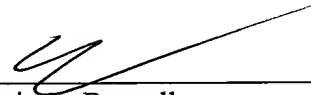
This Amendment is being submitted with a Request for Continued Examination and a Petition for Extension of Time, together with the requisite fees. The Commissioner is hereby authorized to charge any additional fees, or credit any overpayment, to Deposit Account No. 03-1550.

Respectfully submitted,

CHERNOFF, VILHAUER, McCLUNG & STENZEL

Dated: August 4, 2006

By



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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on August 4, 2006.

Dated: August 4, 2006



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